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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,792	05/09/2006	Marc Husemann	101769-315	4883
27384	7590	03/29/2011	EXAMINER	
Briscoe, Kurt G.			REDDY, KARUNA P	
Norris McLaughlin & Marcus, PA			ART UNIT	
875 Third Avenue, 8th Floor			PAPER NUMBER	
New York, NY 10022			1764	
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			03/29/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,792

Applicant(s)

HUSEMANN ET AL.

Examiner

KARUNA P. REDDY

Art Unit

1764

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-12, 14-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-12, 14-17 and 19-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in reference to the amendment filed 3/10/2011. Claims 7-8, 13 and 18 are cancelled. Accordingly, claims 1-6, 9-12, 14-17 and 19-20 are currently pending in the application.

Given that no amendments are made and the grounds of rejection remain unchanged from that set forth in the preceding office action, it is proper to make this action final.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1-2, 4-6, 9-11, 14-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al (5,910,522) in view of Koeble et al (US 4,217,434) and Prucker et al (Macromolecules 1998, 31, 602-613).

Schmidt et al disclose an adhesive comprising a transparent polymer and/or polymerizable oligomer and/or polymerizable monomer suitable for use as an adhesive, nanoscale inorganic particles and optionally compounds for surface modification of said inorganic particles (column 8, claim 1). Polymers that can be preferably employed as transparent polymers include polyacrylates and polymethacrylate. Instead of the mentioned polymers, oligomers and/or precursors (monomers) thereof may be employed as well (column 3, lines 39-61). The listing of nanoscale inorganic particles includes

silicates and SiO_2 (column 4, line 6-10) which has a particle size preferably from 2 to 50 nm and particularly 5 to 20 nm (column 4, lines 36-37). Suitable surface modifier, i.e. surface modifying low molecular weight compounds have at least one functional group capable of reacting with groups present on the surface of powdered particles. Thus, an acid/base reaction may take place between the functional groups of surface modifying compound and surface groups of particles (column 5, lines 29-48). Examples of surface modifier compounds include mono and polycarboxylic acids having 1 to 12 carbon atoms such as acrylic acid and methacrylic acid as well as their esters e.g. methyl methacrylate (column 5, lines 55-63).

The nanoscale particles may be dispersed in one of the solvents and one of the polymerizable compounds (col. 6, lines 34-37). The polymer and polymerizable compounds may be dissolved in or mixed into a stable dispersion of the nanoscale particles, optionally with addition of the surface modifying substances (column 6, lines 44-48). If polymerizable compounds are used, the adhesive also contains thermal or photochemical crosslinking initiators (column 6, lines 49-54). If the adhesive contains a crosslinkable compound, said compound is crosslinked and cured thermally and/or by irradiation depending on the type of crosslinking initiator employed (column 7, lines 19-24). It is the examiner's position that surface modification, of nanoscale particle (i.e. filler), with polymer is implicit in the use of polymerizable compounds as surface modifying substances in the presence to thermal or photochemical crosslinking initiators. Examples of thermal initiators include azobisisobutyronitrile, dibenzoyl peroxide and t-butylperbenzoate (column 7, lines 1-6). Examples of photoinitiators include 1-hydroxycyclohexylphenyl ketone and others (col. 6, lines 55-67) which reads on double bond functionalized photoinitiator of instant claims. Curing conditions (UV wavelength)

depend on the decomposition conditions of crosslinking initiator (col. 7, lines 25-27). It is noted that UV wavelength encompasses UV irradiation in the range of from 200 to 400 nm of instant claims.

A working example of the preparation of adhesive includes mixing methyl methacrylate, SiO_2 and styrene (column 7, lines 53-56). The density of methyl methacrylate and styrene is 0.933 g/cm^3 and 0.907 g/cm^3 respectively (Knovel critical tables - Publication 2003). Therefore, ratio of methyl methacrylate and styrene in working example will read on the weight percentages used in claim 4. The finished adhesive is applied onto a substrate or said substrate is dipped into said adhesive (column 7, lines 13-14).

Schmidt et al is silent with respect to pressure-sensitive adhesive; and coating of filler (i.e. silicate and/or silica gel) with polyacrylate that is chemically bonded to a free-radical initiator which free radical initiator is chemically bonded to silicate and/or silica gel.

However, Schmidt et al in the general disclosure teach that polymers a), nanoscale particles b) and optionally the surface-modifying substances c) may be employed either as such or preferably, as solution in an organic solvents. Examples of suitable solvents are alcohols such as butanol, ketones, hydrocarbons such as hexane, benzene and toluene (col. 6, lines 23-31). Furthermore, Koeble teaches that acrylic pressure sensitive adhesives are well known class of compositions. They are initially liquid adhesive formulations which generally contain a) from about 45 to 65%, by weight of the formulation, of a suitable organic solvent such as butanol, hexane and others; b) from about 16% to about 45%, by weight of the formulation, of polyacrylate component and are generally alkyl esters of either acrylic or methacrylic acid (col. 1, lines 40-67; col.

2, lines 1-5); and c) up to about 5% by weight, of the formulation, of one or more of the following functional additives that include fillers such as silicates. Therefore, given that the adhesive of Schmidt et al comprises solvents, poly(meth)acrylates, and a filler as in the pressure sensitive adhesive formulation of Koeble, the adhesive composition of Schmidt et al is intrinsically capable of functioning as a pressure sensitive adhesive when formulated as a composition comprising solvent, transparent polyacrylates and the silicate filler, in well known proportions used to prepare pressure sensitive adhesives.

With respect to coating of filler (i.e. silicate and/or silica gel) with polyacrylate that is chemically bonded to a free-radical initiator which free radical initiator is chemically bonded to silicate and/or silica gel, Prucker et al teach that grafting of polymer on solid surface by reaction of functional group of the preformed polymer with a corresponding site on the surface of substrate is hampered by intrinsic limitation of the graft density and accordingly layer thickness due to strong kinetic hindrance for the attachment of polymer molecules once the surface is significantly covered. Several studies are done wherein the initiators are attached to the surface of solid substrates (page 602, col. 1, lines 1-21). See figure 1 of Prucker et al, wherein reaction scheme shows covalently attached polymer monolayers on silica surfaces using immobilized AIBN-type azo initiators. Therefore, in light of the teachings in Prucker et al, it would have been obvious to one skilled in art at the time invention was made to attach the azo initiator, of Schmidt et al, to surface of solid materials, such as the nanoparticulate silicates and SiO₂ of Schmidt et al, and polymerize the monomers of Schmidt et al (i.e. acrylic acid and methacrylic acid), because Schmidt et al contemplates surface modification of nanoparticles with polymers and Prucker et al has shown that graft density and accordingly layer thickness of polymer on the solid surface can be controlled by attaching initiator to the solid surface

and then polymerizing monomer on the said surface, and one of ordinary skill in art would expect such a modification to work for the nanoparticle of Schmidt et al, motivated by expectation of success.

4. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al (5,910,522) in view of Koeble et al (US 4,217,434) and Prucker et al (Macromolecules 1998, 31, 602-613).as evidenced by Knovel (Knovel critical tables - Publication 2003).

The discussion with respect to Schmidt et al, Koeble et al and Prucker et al in paragraph 3 above is incorporated herein by reference. Examiner regrets the inadvertent error in omitting the reference to Koeble et al in the statement of rejection in paragraph 5 of office action mailed 12/10/2010.

Schmidt et al, Koeble et al and Prucker et al are silent with respect to weight fraction of polyacrylate coated particles of silicate and/or silica gel.

However, the proportion of nanoscale particles in adhesive composition of Schmidt et al is from 1 to 50 % by volume (column 4, lines 55-56) and weight fraction of instant claim is from 0.5 to 25. The density of inorganic silicates varies over a wide range from 2.0 to 6.5 (see Knovel critical table for density of inorganic silicates). Hence, it is the examiner's position that volume percentages of silicate in Schmidt et al overlaps with weight fraction of present claim. Therefore, it would have been obvious to one skilled in art at the time invention was made to have selected the overlapping range (i.e. weight fraction of 0.5 to 25), from Schmidt et al because court held that when the range of instant claims and that disclosed in prior art overlap, a prima facie case of

obviousness exists. See *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).
See MPEP § 2144.05.

Response to Arguments

5. Applicant's arguments filed 3/10/2011 have been fully considered but they are not persuasive. Specifically, applicant argues (A) examiner turns to Koeble to show that the adhesive composition of Schmidt is intrinsically capable of functioning as a PSA when formulated as a composition comprising solvent, transparent polyacrylates and the silica filler in well known proportions used to prepare PSA's. When all that is done, who can say whether Schmidt's adhesive adhesives have that capacity or not. Why persons skilled in the art would have gone to such trouble; (B) Schmidt's mode of operating is to apply the liquid adhesive directly to the substrates to be connected, then cure the adhesive as the way of affecting the bond. Proposed modification cannot render the prior art unsatisfactory for its intended purpose. Examiner is turning the Schmidt's reference on its head, converting a liquid contact adhesive into a pressure sensitive adhesive.

With respect to (A), Schmidt et al teach that polymers, nanoscale particles and the surface modifying substances may be employed as such or preferably, as solution in organic solvents. Furthermore, Koeble et al teach that PSA's can be prepared from the components already present in the adhesive composition of Schmidt et al. Hence, it is the examiner's position that composition of Schmidt et al is intrinsically capable of functioning as a PSA when formulated as a composition comprising solvent, transparent polyacrylates and the silica filler, in well known proportions used to prepare PSA's. It

would have been prima facie obvious to one skilled in art looking to prepare a PSA from a known adhesive composition using a well known procedure. Since PTO cannot conduct experiments, the burden of proof is shifted to the applicants to show why the composition of Schmidt et al in view of Koeble is not capable of functioning as a PSA.

With respect to (B), there is nothing on the record or in the cited prior art to indicate that PSA's cannot be applied to a substrate and cured to affect the bond. Applicant has not provided any evidence to show that the composition of Schmidt after formulation as a PSA based on the well known procedure of Koeble, would be unsatisfactory in functioning as a liquid adhesive. Applicant's arguments cannot take the place of factual evidence.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KARUNA P. REDDY whose telephone number is (571)272-6566. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. P. R./
Examiner, Art Unit 1764

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1764